

Remarks

Applicants have canceled claims 1-11 and 14-22 without prejudice or disclaimer. New claims 23-42 have been added in order to claim additional embodiments of the subject matter of the provisionally-elected group. New claims 23-42 find support throughout the specification and claims as originally filed, and thus no new matter has been added.

Originally filed claims 12-13 and new claims 23-42 are pending.

I. Objection to X, Y, and Z

The Examiner has objected to the terms SEQ ID NO:X, SEQ ID NO:Y, and ATCC Deposit No. Z, alleging that the disclosure does not identify such terms. In response, Applicants respectfully direct the Examiner to the specification at paragraphs 10, 16-17, 24, and 130-136, as well as Table 1 on pages 34-35, which clearly describes the meaning of these terms. However, Applicants also note that new claims 23-42 do not contain such terms.

II. The Restriction Requirement

Pursuant to the Office Action mailed July 16, 2003 (Paper No. 8), the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I to VIII. The Examiner contends that the inventions of the Groups are distinct, each from the other. The Examiner has also required a further election under 35 U.S.C. § 121 of a DNA SEQ ID NO (X) encoding a polypeptide SEQ ID NO (Y), and a corresponding ATCC Deposit No. (Z) from those listed in Table 1.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of Group 1, directed to polynucleotides encoding SEQ ID NO:20, including but not limited to SEQ ID NO:6 and the cDNA clone contained in plasmid HIBCJ89 in ATCC Deposit No. PTA1429.

With respect to the Examiner's restriction of groups directed to a nucleic acid sequence, polypeptides encoded thereby, antibodies recognizing such polypeptides, and methods of using the same, Applicants traverse. As the Examiner has implicitly recognized, even where patentably distinct inventions appear in a single application,

restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". *See* M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups I-VIII are separately classified or represent divergent subject matter, Applicants nonetheless submit that, with respect to a given sequence, a search of the claims of the groups directed to that sequence would also provide useful information for the claims of the other groups directed to that sequence. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. Thus, since the searches for proteins, nucleic acids encoding such proteins, antibodies to such proteins, and methods of making and using the same commonly overlap, Applicants respectfully submit that the Examiner's assertion that the combined search and examination of such compositions and methods using the same would entail a serious burden as to a particular sequence has been rebutted, even assuming *arguendo* that all of the searches were not coextensive.

Accordingly, in view of M.P.E.P. § 803, claims directed to polynucleotides encoding SEQ ID NO:20, the polypeptides encoded thereby, antibodies recognizing such polypeptides, and methods of using the same should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

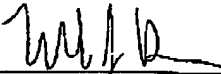
Entry of the above amendment is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an additional

extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: November 17, 2003


Mark J. Hyman
Attorney for Applicants

Reg. No. 46,789

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
Telephone: (240) 314-1224